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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,376	03/20/2002	Serge Haumont	4925-184PUS	9736

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EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/980,376

**Applicant(s)**

HAUMONT ET AL.

**Examiner**

Joy K. Contee

**Art Unit**

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17,19,21-60 and 77-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17,19,21-60 and 77-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 11-17, 19, 21-60 and 77-96 have been considered but are moot in view of the new ground of rejection. Examiner has reapplied Rinne et al. (6,574,43) teaching; however, the rejection is modified (i.e., additional portions of text are cited from reference and different interpretations of claims are explained), hence the new ground of rejection found below.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: in line 4 "end station" should be "mobile station" in accordance with Applicant's current amendment. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined

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under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1,3,5,7,12-14,16-17,19,21 are rejected under 35 U.S.C. 102(e) as being anticipated by Rinne et al. (Rinne), U.S. Patent No. 6,574,473.

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Rinne discloses a network element (i.e., reads on radio network controller) for use in a communication network, said network element being arranged between a mobile station (i.e., or terminal) and an end element (i.e., reads on MSC), wherein connections are established between said mobile station and said end element (MSC) via said network element (col. 5, lines 35-45 and col. 8, lines 23-32, see Fig. 7), said network element comprising means for determining if the connection between said end element and said mobile station is to be released (i.e., handover from one anchor RNC to other RNC, wherein link between anchor RNC and old RNC is removed, hence connection between end element or MSC and mobile station is released) (col. 6, lines 4-14, col. 8, lines 23-31 and col. 10, lines 7-18, see Fig. 7).

Regarding claim 2, Rinne discloses a network element as claimed in claim 1, wherein said network element is arranged to release said connection when the

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determining means determines that the connection is to be released (col. 3, lines 24-42 and col. 4, lines 40-48).

Regarding claim 3, Rinne discloses a network element as claimed in claim 2, wherein said network element is arranged to release the connection between the network element and said mobile station (col. 5, lines 35-45, col. 7, lines 56-67 and col. 10, lines 7-29).

Regarding claims 4-8 and 23, Rinne discloses a network element as claimed in claims 1, 5, 6, 7 and 3, respectively, wherein said network element is arranged to send a message (and request and in response to a release command received from end element) (i.e., release bearers or handover complete) to the end element indicating that said connection has been released (col. 10, line 44 to col. 11, line 57 and see Figs. 11 and 12).

Regarding claim 12, 31-40, Rinne discloses a network element as claimed in claims 1-11, respectively, wherein said determining means is arranged to determine if the connection is to be released based on the state of the mobile station (col. 10, lines 44-53).

Regarding claim 13-17, 41-60, Rinne discloses a network element as claimed in claims 1-11, respectively, wherein said determining means is arranged to determine if the connection should be released based on the movement (and location) of said mobile station (i.e., reads on the fact that handover is determined based on location or movement of mobile station within the base station set of a radio network controller) (col. 17, lines 19-45).

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Regarding claims 19,77-93, Rinne discloses a network element as claimed in claims 1-11, respectively, wherein said network element is a radio network controller (col. 5, lines 35-45) and includes an end station (i.e., reads on mobile station) and an end element (i.e., reads on base station) (col. 5, lines 35-45).

Regarding claims 21-22,94-96, Rinne discloses a network element as claimed in claim 19, wherein said end element is SGSN and said network operates in accordance with the UMTS standard (col. 2, line 65 to col. 3, line 7 and col. 15, lines 8-11).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-11,24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rinne, in view of Blausten, U.S. Patent No. 4,443,875.

Regarding claims 9-11, 24-30, Rinne discloses a network element as claimed in claims 1-8, respectively. Rinne fails to explicitly disclose wherein said determining means determines that the connection is to be released if the connection has not been used for a predetermined time.

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In a similar field of endeavor, Blausten discloses wherein said determining means determines that the connection is to be released if the connection has not been used for a predetermined time (col. 3, lines 24-31).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Rinne to include a elapse time for terminating a connection for handoff for the purpose of delaying the process request is the connection is not being used, hence preserving resources.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 571.272.7906. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571.272.7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC

  
**JOY K. CONTEE**  
**REGISTERED EXAMINER**